
ESSAY

WHAT IS A “USEFUL ARTICLE” IN COPYRIGHT LAW AFTER *STAR ATHLETICA*?†

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I. INTRODUCTION

The U.S. Supreme Court granted certiorari in *Star Athletica, LLC v. Varsity Brands, Inc.* to decide “[w]hat is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act?”¹ The Supreme Court likely granted certiorari because the Sixth Circuit identified no fewer than *nine* different tests that courts and commentators had proposed for resolving the issue,² and the Sixth Circuit adopted a tenth.³ The Supreme Court then issued its own opinion on March 22, 2017,⁴ setting

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¹ Petition for a Writ of Certiorari at i, *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866), 2016 WL 94219.

² See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484-85 (6th Cir. 2015) (noting that “[c]ourts have struggled mightily to formulate [such] a test”), *aff’d*, 137 S. Ct. 1002 (2017).

³ See *id.* at 487-89 (listing a series of five questions to determine whether a design is a copyrightable PGS work).

⁴ *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).

forth a two-part test grounded in the text of the statute⁵ while rejecting several proposed alternatives.⁶

But there is an antecedent question that must be answered before the Supreme Court's two-part test in *Star Athletica* may be invoked; namely, whether the pictorial, graphic, or sculptural work at issue is the design of a "useful article" in the first place. On this question, the Supreme Court's opinion is disappointingly silent.

The parties in *Star Athletica* and the Court both implicitly assumed, without analysis, that the cheerleading uniforms at issue were "useful articles." That is likely the correct conclusion; however, the "useful articles" doctrine has always been an uncomfortable "fit" for clothing, costumes, and other garments, and there will undoubtedly be future cases involving other types of allegedly useful articles in which the antecedent question is even less certain. This essay aims to patch that gap, by providing guidance on the antecedent question of "what is a useful article?"

II. THE STATUTORY FRAMEWORK

Under section 102(a) of the Copyright Act, copyright protects "original works of authorship fixed in any tangible medium of expression."⁷ The statute lists eight categories of works of authorship, including "pictorial, graphic, and sculptural works."⁸ Protection for all works is subject to the exclusion in section 102(b): "In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery."⁹ This exclusion serves two purposes: first, the exclusion of any "procedure, process, system, [or] method of operation" helps to separate copyright protection from patent protection, so that potentially patentable inventions are required to meet the more stringent standards of patent law;¹⁰

⁵ *Id.* at 1007, 1012; *see also id.* at 1010 ("This is not a free-ranging search for the best copyright policy, but rather depends solely on statutory interpretation." (internal citation omitted) (internal quotation marks omitted)).

⁶ *See id.* at 1013-14 (rejecting the "equally useful" standard and the proposed distinction between "physical" and "conceptual" separability); *id.* at 1015 (rejecting the *Brandir* design-process test and the marketability test).

⁷ 17 U.S.C. § 102(a) (2012).

⁸ *Id.*

⁹ 17 U.S.C. § 102(b) (2012).

¹⁰ *See* Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493, 1494 n.5 (2017) (identifying "the exclusions of processes, systems, and methods of operation" as one of "[t]he main copyright doctrines that channel patent subject matters out of copyright's domain"); Pamela Samuelson, *Why Copyright Law Excludes Systems and Processes From the Scope of Its Protection*, 85 TEX. L. REV. 1921, 1932 (2007) ("The principal explanation . . . for excluding systems and other useful arts described or otherwise depicted in copyrighted works from the scope of copyright" is to separate patent and copyright); *see also* Bruce

and second, the exclusion of any “idea, . . . concept, principle, or discovery” keeps these basic “building blocks” in the public domain, where they may be disseminated and debated without restriction.¹¹

The category of “pictorial, graphic, and sculptural works” (or PGS works) is further defined in section 101. The first sentence of the definition (using the verb “include”) is simply a list of examples of works that fall within the category of PGS works. The list includes the phrase “applied art,” which the Supreme Court defined as follows:

“Applied art” is art “employed in the decoration, design, or execution of useful objects,” Webster’s Third New International Dictionary 105 (1976) (emphasis added), or “those arts or crafts that have a *primarily utilitarian function*, or . . . the designs and decorations used in these arts,” Random House Dictionary 73 (1966) (emphasis added); see also 1 OED 576 (2d ed. 1989) (defining “applied” as “[p]ut to practical use”).¹²

Thus, using the first dictionary definition supplied by the Court, the first sentence of the statutory definition of PGS works indicates that art “employed in the decoration [or] design” of a useful object or article is potentially copyrightable as a PGS work. The second dictionary definition supplied by the Court has two alternatives, which are separated by the word “or.” In context, only the second alternative—“the designs and decorations used in these arts”—makes sense. The first alternative is expressly excluded from the scope of copyright protection by the second sentence of the statutory definition, which provides that “works of artistic craftsmanship” are protected only “insofar as their form but not their mechanical or utilitarian aspects are

E. Boyden, *Games and Other Uncopyrightable Systems*, 18 GEO. MASON L. REV. 439, 447 (2011) (describing section 102(b) as “devoted to drawing the line between patents and copyrights”).

¹¹ See Samuelson, *Why Copyright Law Excludes Systems and Processes From the Scope of Its Protection*, *supra* note 10, at 1928 (“Freeing abstract ideas and concepts from copyright’s constraints advances freedom of speech and expression interests of subsequent authors and of users of protected works.”); *id.* at 1927 (praising “the social desirability of allowing free reuse of fundamental building blocks of knowledge”).

¹² *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1014 (2017). Although the parenthetical after the first dictionary definition states “emphasis added,” there is no emphasis in the first dictionary definition in the Court’s slip opinion. Perhaps this omission will be rectified when the final published opinion is released in the U.S. Reports. See also *Cheffins v. Stewart*, 825 F.3d 588, 594 (9th Cir. 2016) (“[A]n object constitutes a piece of ‘applied art’ . . . where the object initially served a utilitarian function and the object continues to serve such a function after the artist made embellishments or alterations to it.”); *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 84-85 (2d Cir. 1995) (“‘Applied art’ describes two- and three-dimensional ornamentation or decoration that is affixed to otherwise utilitarian objects.” (internal quotation marks omitted) (citing *Carter v. Helmsley Spear, Inc.*, 861 F.Supp 303, 316 (S.D.N.Y. 1994))).

concerned.”¹³ This language implements the idea/expression distinction set forth in section 102(b).¹⁴

The statutory definition also provides that “the design of a useful article” is included in the category of PGS works “only if, and only to the extent that” it contains PGS “*features* that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”¹⁵ A “feature” of a design is necessarily something less than the whole design.¹⁶ When combined with the first clause of the second sentence of the statutory definition, this last clause indicates two things: first, that copyright does not protect the overall design of a useful article;¹⁷ and second, that when a design contains PGS features that *do* meet the criteria, copyright protects *only those features*.¹⁸ Any “mechanical or utilitarian aspects” of the useful article are excluded from copyright protection.

Section 101 also contains a definition of a “useful article.” This definition will be examined below, after briefly reviewing the legal proceedings and opinions in *Star Athletica*.

III. THE COURT OPINIONS

On July 9, 2010, Varsity Brands filed an infringement action against Star Athletica, alleging that the defendant unlawfully copied five of Varsity’s

¹³ 17 U.S.C. § 101 (2012).

¹⁴ See *Ultraflo Corp. v. Pelican Tank Parts, Inc.*, 845 F.3d 652, 657 (5th Cir. 2017) (“[T]he exclusion of useful articles from copyright protection is a corollary of the idea-expression dichotomy”); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 913 (2d Cir. 1980) (“Just as copyright protection extends to expression but not ideas, copyright protection extends only to the artistic aspects, but not the mechanical or utilitarian features, of a protected work.”).

¹⁵ 17 U.S.C. § 101 (2012) (defining “pictorial, graphic, and sculptural works”) (emphasis added).

¹⁶ A “feature” is “[a] distinctive or characteristic part of a thing.” 5 THE OXFORD ENGLISH DICTIONARY 790 (2d ed. 1989). See also THE RANDOM HOUSE DICTIONARY 704 (2d ed. 1987) (“a prominent or conspicuous part or characteristic”); WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 832 (1966) (“a marked element of something: something that is especially prominent”).

¹⁷ See H.R. REP. NO. 94-1476, at 55 (1976), reprinted in 1976 U.S.C.C.A.N. at 5668 (“[A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill.”).

¹⁸ See *Baby Buddies, Inc. v. Toys “R” Us, Inc.*, 611 F.3d 1308, 1316 (11th Cir. 2010) (“Thus, a useful article, as a whole, does not receive copyright protection, but any constituent design elements that can be physically or conceptually separated from the underlying article can receive copyright protection.”); *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970, 972 (6th Cir. 1983) (“This portion of the definition indicates that ‘useful articles’ are not generally copyrightable, although certain features of ‘useful articles’ may be copyrighted separately.”); H.R. REP. NO. 94-1476, at 55 (1976) (“[E]ven if the three-dimensional design contains some such [separable] element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.”).

cheerleading uniform designs.¹⁹ The district court granted the defendant's motion for summary judgment,²⁰ declaring "the colors-and-designs component[s]" were essential to the uniforms, because "a cheerleading uniform loses its utilitarian function as a cheerleading uniform when it lacks all design and is merely a blank canvas."²¹

The Sixth Circuit vacated the judgment and entered partial summary judgment in favor of Varsity, upholding the copyrightability of its designs.²² In its separability analysis, the Sixth Circuit identified nine different approaches that courts and commentators had used or proposed,²³ and it adopted a tenth:

(1) Is the design a pictorial, graphic, or sculptural work? (2) If the design is a pictorial, graphic, or sculptural work, then is it a design of a useful article[?] . . . (3) What are the utilitarian aspects of the useful article? . . . (4) Can the viewer of the design identify pictorial, graphic, or sculptural features separately from . . . the utilitarian aspects of the useful article? . . . (5) Can the pictorial, graphic, or sculptural features of the design of the useful article exist independently of the utilitarian aspects of the useful article?²⁴

The majority answered these questions as follows: (1) Varsity's designs are two-dimensional works of graphic art;²⁵ (2) Varsity's designs are of cheerleading uniforms, which meet the statutory definition of useful articles;²⁶ (3) the utilitarian aspects of cheerleading uniforms are to "cover the body, wick away moisture, and withstand the rigors of athletic movements";²⁷ (4) "the arrangement of stripes, chevrons, zigzags, and color-blocking" on the uniforms can be identified separately from the utilitarian aspects, because those features do not affect the utility of the clothing;²⁸ and (5) "the

19 Complaint at ¶ 14, *Varsity Brands, Inc. v. Star Athletica, LLC*, (W.D. Tenn. July 9, 2010) (No. 2:10-CV-02508) 2010 WL 5788167. The specific allegations of infringement are at ¶¶ 28, 35, 41, 48, and 55. All five of the contested designs are pictured in the Appendix to Opinion of the Court. See *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1017 (2017).

20 *Varsity Brands, Inc. v. Star Athletica, LLC*, 110 U.S.P.Q. 2d 1150 (W.D. Tenn. Mar. 1, 2014), available at 2014 WL 819422, *rev'd*, 799 F.3d 468 (6th Cir. 2015), *aff'd*, 137 S.Ct. 1002 (2017).

21 *Id.* at 1156, 2014 WL 819422 at *8.

22 *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 494 (6th Cir. 2015), *aff'd*, 137 S. Ct. 1002 (2017).

23 *Id.* at 484-85 (listing the Copyright Office's approach, the primary-subsidary approach, the objectively necessary approach, the ordinary-observer approach, the design-process approach, the stand-alone approach, the likelihood-of-marketability approach, Patry's approach, and the subjective-objective approach).

24 *Id.* at 487-88 (internal brackets and quotation marks omitted).

25 *Id.* at 489.

26 *Id.* at 489-90.

27 *Id.* at 490.

28 *Id.* at 491.

arrangement of stripes, chevrons, color blocks, and zigzags” can exist independently of the uniforms, because a) they may be printed on other articles, or framed and hung on the wall as art; and b) they are “wholly unnecessary” to the uniforms’ “ability to cover the body, permit free movement, and wick moisture.”²⁹

Star Athletica filed a petition for a writ of certiorari, which the U.S. Supreme Court granted, limited to Question 1 of the petition: “What is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act?”³⁰ Writing for the majority, Justice Thomas summarized the Court’s holding in the second paragraph of his opinion:

We hold that a feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.³¹

One of the most significant aspects of the Supreme Court’s standard is that it is expressly recursive. To determine whether a design feature of a useful article is protected by copyright as a PGS work, one must determine if it “(1) ‘can be identified separately from,’ and (2) is ‘capable of existing independently of, the utilitarian aspects of the article.’”³² But the allegedly separable feature “cannot itself be a useful article” (or a utilitarian part of a useful article),³³ because it would then be excluded from the definition of a PGS work. Thus, if the allegedly separable feature has any utilitarian aspects, one must repeat the process until one succeeds (or fails) in identifying a feature that does *not* have any utilitarian aspects.

To apply the Supreme Court’s two-part standard, therefore, it would be helpful for a lower court to expressly identify the utilitarian aspects of the article it is considering, so that it can more easily determine if the allegedly separable feature(s) can exist independently of those utilitarian aspects. Unfortunately, the Supreme Court did not *expressly* so require, and the majority opinion identified the utilitarian aspects of the cheerleading

²⁹ *Id.* at 491-92.

³⁰ Petition for a Writ of Certiorari at i, *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866), 2016 WL 94219; *Star Athletica, LLC v. Varsity Brands, Inc.*, 136 S. Ct. 1823, 1823 (2016).

³¹ *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017).

³² *Id.* at 1010 (quoting 17 U.S.C. § 101 (2012)).

³³ *Id.*; *see also id.* at 1013-14 (“Of course, because the removed feature may not be a useful article—as it would then not qualify as a pictorial, graphic, or sculptural work—there necessarily would be some aspects of the original useful article ‘left behind’ if the feature were conceptually removed.”).

uniforms only implicitly.³⁴ By contrast, one of the virtues of the Sixth Circuit's five-question approach is that the third question expressly requires a lower court to identify the utilitarian aspects of the article before it.³⁵ However, although the Supreme Court's opinion does not expressly endorse the Sixth Circuit's five-question approach, it is important to note that *the Sixth Circuit's five-question approach is consistent with the Supreme Court's two-part approach*. If one examines the five questions closely, one sees that the Supreme Court's two-part approach is nothing more than a restatement of the last two questions of the Sixth Circuit's five-question approach.³⁶

In Section II.A of the Supreme Court's opinion, the answers to the first three questions posed by the Sixth Circuit are either implicitly assumed to exist or are summarily dispatched,³⁷ so that it can focus on the question on which it granted certiorari (how to answer Questions (4) and (5)). But that doesn't mean that the first three questions of the Sixth Circuit's approach should be disregarded by subsequent lower courts. To the contrary, to properly apply the Supreme Court's standard, a lower court should *expressly* consider the first three questions of the Sixth Circuit's five-question approach, before turning to the Supreme Court's modification of the last two questions of the Sixth Circuit's approach.

IV. THE STATUTORY DEFINITION OF A "USEFUL ARTICLE"

Section 101 defines a "useful article" as follows: "A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article'."³⁸ The second sentence captures any functional components of a useful article, such as the nuts and bolts that hold it together, or the electronic components embedded within it.³⁹

³⁴ See *infra* Part V.

³⁵ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 487 (6th Cir. 2015) ("(3) What are the utilitarian aspects of the useful article?"), *aff'd*, 137 S. Ct. 1002 (2017).

³⁶ Compare *id.* at 488, with *Star Athletica*, 137 S. Ct. at 1007. See also *id.* at 1016 (using essentially the same language).

³⁷ See *Star Athletica*, 137 S. Ct. at 1009 (finding that each of Varsity's works are the "design of a useful article," without either defining the term "useful article" or identifying the utilitarian functions of those articles).

³⁸ 17 U.S.C. § 101 (2012).

³⁹ See *Langman Fabrics v. Graff Californiawear, Inc.*, 160 F.3d 106, 114 (2d Cir. 1998) ("The statutory definition of 'useful article' includes its components Thus, the necessity of an item being incorporated in a larger article does not deprive it of 'usefulness' under the statute."), *opinion amended*, 169 F.3d 782 (2d Cir. 1998) ("[F]abric manufactured for the purpose of being made into clothing is a 'useful article'"); *Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) ("[W]heel covers are utilitarian articles serving as hubcaps to protect lugnuts, brakes, wheels, and axles from damage and corrosion [Moreover,] the wheel covers were designed to be part of an automobile, which is a useful article."). Cf. *Lanard Toys, Ltd. v. Novelty, Inc.*, No. CV 05-8406-GW (JWJx), 2008 WL 11333941, at *3 (C.D. Cal. Mar. 18, 2008) ("The fact that the disputed

The first sentence of the statutory definition is broad in scope: it captures *any* article that has “an intrinsic utilitarian function.” That broad scope is then narrowed, because two utilitarian functions are excluded from the scope of the definition. The first exclusion requires that the work’s function is “not merely to portray the appearance of the article.” For example, a portrait of a person (or a sculpted bust of a person) is useful in an ordinary sense, but it is *not* a useful article within the meaning of the statute, because its only utility is that it shows us the appearance of its subject. Similarly, two courts have held that animal mannequins used by taxidermists to mount animal skins are not “useful articles,” because their only function is to depict what the animal looks like.⁴⁰ Another court held that the pedestal on which a sculpture was placed, which was designed to look like a steam grate, was not a “useful article” because it “was designed and constructed precisely ‘to portray the appearance of’ an actual streetside grate.”⁴¹

The second exclusion excludes articles whose utility is “to convey information.” Thus, “maps, globes, charts, [and] diagrams” are expressly included in the definition of “pictorial, graphic, or sculptural works.”⁴² Maps, globes, and charts are useful because they convey information about the world around us.⁴³ Diagrams are similarly useful because they convey information about the things depicted. These works are *not* subject to separability analysis, because they are excluded from the definition of “useful articles.” Moreover, because the statutory limitation on the copyrightability of “useful articles” is contained only in the definition of “pictorial, graphic, or sculptural works,”

portion [i.e., component] of the launcher has an intrinsic utilitarian function (as a handle) will normally preclude copyright protection as to its mechanical or utilitarian features.”), *aff’d on other grounds*, 375 Fed. App’x 705 (9th Cir. 2010).

40 See *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 323 (2d Cir. 1996) ([B]ecause fish mannequins are “designed to be looked at” and “are useful [only] insofar as they ‘portray the [ir] appearance[.]’ [t]hat makes them copyrightable.” (citation omitted)); *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 491 (4th Cir. 1996) (“Because these animal mannequins were designed to portray the appearance of animals . . . , we hold that they are not ‘useful articles’ as defined in the Copyright Act”).

41 *Cnty. for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1496 (D.C. Cir. 1988), *aff’d on other grounds*, 490 U.S. 730, 736 (1989). The mechanism that produced the steam, however, is a useful article.

42 17 U.S.C. § 101 (2012) (defining “pictorial, graphic, or sculptural works”).

43 Although the word “chart” could refer to its current primary definition, “[a] sheet of information in the form of a table, graph, or diagram,” the history of copyright law suggests that it carries its more specialized meaning: a marine map that depicts underwater features for navigation. *Chart*, OXFORD ENGLISH ONLINE DICTIONARY, <https://en.oxforddictionaries.com/definition/us/chart> [https://perma.cc/R5CS-JNJJ] (providing a secondary definition of a chart as a “geographical map or plan, especially one used for navigation by sea or air.”); see, e.g., *Blunt v. Patten*, 3 F. Cas. 762, 762 (C.C.S.D.N.Y. 1828) (No. 1,579); *Blunt v. Patten*, 3 F. Cas. 763, 764 (C.C.S.D.N.Y. 1828) (No. 1,580) (using the specialized meaning). Both “maps” and “charts” have been protected since the Copyright Act of 1790. See Copyright Act of 1790, ch. 15, § 1 Stat. 124 (“any map, chart, book or books”).

literary works are not subject to separability analysis,⁴⁴ although they are still subject to section 102(b).

Case law holds that the two statutory exclusions preclude classifying an article as “useful” when the “utilitarian function” is merely imaginative or philosophical. In *Masquerade Novelty, Inc. v. Unique Industries, Inc.*, for example, the court considered the copyrightability of the plaintiff’s “nose masks” (masks representing the noses of pigs, elephants, and parrots).⁴⁵ The parties agreed that the purpose of the nose masks was “to be worn over the nose of a person to simulate the nose of the respective animals.”⁴⁶ The district court granted summary judgment to the defendants on the ground that the masks were “conceptually inseparable from the product’s utilitarian purpose of creating humor.”⁴⁷ Reversing and remanding, the Third Circuit rejected the premise that the nose masks were “useful articles” within the meaning of the statute: “That nose masks are meant to be worn by humans to evoke laughter does not distinguish them from clearly copyrightable works of art like paintings.”⁴⁸ Similarly, in *Gay Toys, Inc. v. Buddy L Corp.*,⁴⁹ the district court held that “[a] toy airplane is useful and possesses utilitarian and functional characteristics in that it permits a child to dream and to let his or her imagination soar.”⁵⁰ The Sixth Circuit rejected this holding: “[A] toy airplane is merely a model which portrays a real airplane. To be sure, a toy airplane is to be played with and enjoyed, but a painting of an airplane, which is copyrightable, is to be looked at and enjoyed.”⁵¹ Thus, the “intrinsic utilitarian function”⁵² cannot be one which merely stimulates the mind of an observer; instead, it must be one which accomplishes a practical result.

Taken together, the two statutory exclusions preserve the well-established distinction between “models” and “technical drawings” (which are expressly included in the definition of “pictorial, graphic, and sculptural works”) and the useful articles that are constructed based upon those preparatory works. A model is useful because it shows us (often in miniature) what the completed article will look like. A technical drawing is useful because it conveys

⁴⁴ See *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 202 (9th Cir. 1989) (“The useful article exception therefore cannot apply to textual portions of the organizers.”).

⁴⁵ 912 F.2d 663 (3d Cir. 1990).

⁴⁶ *Id.* at 666 (brackets and emphasis omitted).

⁴⁷ *Id.* at 670 (quoting district court opinion).

⁴⁸ *Id.* at 671. The court acknowledged, however, that “Masquerade may have difficulty in demonstrating infringement on remand,” because the idea-expression distinction limits the scope of copyright in realistic depictions of animals. *Id.* at 671-72.

⁴⁹ 522 F. Supp. 622 (E.D. Mich. 1981), *vacated and remanded*, 703 F.2d 970 (6th Cir. 1983).

⁵⁰ *Id.* at 625.

⁵¹ *Gay Toys, Inc.*, 703 F.2d at 973.

⁵² *Id.* (quoting 17 U.S.C. § 101).

information about how to construct a useful article.⁵³ In both cases, the model or technical drawing is subject to copyright, so that the model or drawing cannot be reproduced, even though copyright does *not* include the right to construct the useful article that is depicted in the model or technical drawing.⁵⁴ Thus, for example, a toy airplane or model airplane that does not fly is not a “useful article,” because its only utility is to depict what the airplane looks like.⁵⁵ If the toy airplane flies, however, that is an “intrinsic utilitarian function,” so that the flying mechanism and other aerodynamic features cannot be protected by copyright.⁵⁶

Both the majority and dissenting opinions in *Star Athletica* recognize the distinction between a model or drawing (an eligible pictorial, graphic, or sculptural work) and the useful article that is depicted in the model or

⁵³ See, e.g., *Eales v. Envtl. Lifestyles, Inc.*, 958 F.2d 876, 879-80 (9th Cir. 1992) (“The intrinsic function of an architectural plan is to convey the information necessary to enable the reader to construct a building. It is settled law that architectural drawings and plans are thus eligible for protection under the copyright code....”); *Gemel Precision Tool Co. v. Pharma Tool Corp.*, 35 U.S.P.Q.2d 1019, 1022-23, 1995 WL 71243, at *4 (E.D. Pa. 1995) (“The purpose of a blueprint is to portray the appearance of the article depicted therein As such, blueprints cannot be considered useful articles under § 101.”).

⁵⁴ See 17 U.S.C. § 113(b) (“This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any . . . rights with respect to the making . . . of the useful article so portrayed....”); H.R. REP. NO. 94-1476, at 105 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5720 (“[C]opyright in a pictorial, graphic, or sculptural work, portraying a useful article as such, does not extend to the manufacture of the useful article itself[.]”); *Ultraflo Corp. v. Pelican Tank Parts, Inc.*, 845 F.3d 652, 658 (5th Cir. 2017) (“Although the Copyright Act provides the owner of such a drawing the exclusive right to reproduce the drawing itself, it does not grant the exclusive right to use the drawing to make the useful article depicted.”); *Forest River, Inc. v. Heartland Recreational Vehicles, LLC*, 753 F. Supp. 2d 753, 758-60 (N.D. Ind. 2010) (rejecting argument that “a copyright in a technical drawing of a non-architectural useful article precludes another party from using copies of that drawing to construct the useful article,” but allowing “a claim for copyright infringement as to the copies (as distinct from the actual [article])”).

It should be noted that the Architectural Works Copyright Protection Act of 1990, Pub. L. No. 101-650, tit. VII, 104 Stat. 5089, 5133, changes this result for an “architectural work.” Under the AWCPA, the owner of copyright in an architectural work, as embodied in plans or drawings, now has the exclusive right to construct the building depicted, as well as the exclusive right to reproduce the plans or drawings themselves. H.R. REP. NO. 101-735, *reprinted in* 1990 U.S.C.C.A.N. 6935, 6950, 6954 (1990). The distinction between drawings and the articles they depict still holds, however, for all other types of useful articles.

⁵⁵ *Gay Toys, Inc.*, 703 F.2d at 973.

⁵⁶ See *Boyd's Collection, Ltd. v. Bearington Collection, Inc.*, 365 F. Supp. 2d 612, 617 (M.D. Pa. 2005) (“A scale model plane that serves as a child’s toy is not a useful article, but a scale model plane that serves as a pilotless military drone likely is.”). *Cf.* *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 915 (2d Cir. 1980) (“The levers and buttons of [one] game and the steering wheel and moving path of [another] game are the mechanisms that make the games work” and are therefore utilitarian aspects not subject to copyright); *Lego A/S v. Best-Lock Constr. Toys, Inc.*, 874 F. Supp. 75, 98 (D. Conn. 2012) (“Most courts in this circuit appear to define the ‘functional’ aspects of a toy implicitly as those aspects that involve movement or attachment.”).

drawing.⁵⁷ The dissenting opinion praised this aspect of the decision as “[t]he most direct, helpful aspect of the Court’s opinion,”⁵⁸ and it added that “the purpose of § 113(b) was to ensure that ‘copyright in a pictorial, graphic, or sculptural work, portraying a useful article as such, does not extend to the manufacture of the useful article itself.’”⁵⁹ This limitation “serves the important policy of keeping patent and copyright separate by preventing parties from using copyright to obtain a ‘backdoor patent’ on a functional article that cannot be patented.”⁶⁰

V. APPLYING THE STATUTORY DEFINITION

The above discussion recommends that, in order to determine whether an article is a “useful article” within the meaning of the statute, a court should first identify the “intrinsic utilitarian function” or functions served by the article. It should then ask whether the article is excluded from the statutory definition because the only functions are “merely to portray the appearance of the article or to convey information.”⁶¹ In doing so, the court should expressly identify the utilitarian “aspects” of the article. Only after doing so should a court proceed to inquire whether there are any “pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article,”⁶² in the manner directed by the Supreme Court.

The Court, unfortunately, skipped straight to the two-part separability test and did not expressly answer any of these antecedent questions. The Court’s entire discussion of the antecedent questions is contained in Part I.A.1 of the opinion, which rejected the argument that two-dimensional works are not subject to “separability” analysis.⁶³ This passage is remarkable for its lack of analysis. The Court does not expressly ask whether the cheerleading

⁵⁷ *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (“Nor could someone claim a copyright in a useful article merely by creating a replica of that article in some other medium—for example, a cardboard model of a car. Although the replica could itself be copyrightable, it would not give rise to any rights in the useful article that inspired it.”); *id.* at 1033 (Breyer, J., joined by Kennedy, J., dissenting) (“The law has long recognized that drawings or photographs of real world objects are copyrightable as drawings or photographs, but the copyright does not give protection against others making the underlying useful objects.”).

⁵⁸ *See id.* at 1031.

⁵⁹ *Id.* at 1033 (quoting H.R. REP. NO. 94-1476, at 105 (1976)).

⁶⁰ *Smith & Hawken, Ltd. v. Gardendance, Inc.*, 75 U.S.P.Q.2d 1853, 1855, 2005 WL 1806369, at *3 (N.D. Cal. 2005). *See also* Viva R. Moffat, *The Copyright/Patent Boundary*, 48 U. RICH. L. REV. 611, 620 (2014) (“[I]t is reasonable to conclude that the primary purpose of the ‘useful article’ doctrine is to police the boundary between copyright law and patent law.”).

⁶¹ 17 U.S.C. § 101 (2012).

⁶² *Id.*

⁶³ *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1009 (2017).

uniforms are useful articles, nor does it expressly identify what utilitarian function or functions (or aspects) the uniforms have. Instead, the Court implicitly *assumed* that the uniforms were useful articles. And the only evidence we have of the majority's view of the "utilitarian aspects" of the uniforms is contained in the following passage:

To be clear, the only feature of the cheerleading uniform eligible for a copyright in this case is the two-dimensional work of art fixed in the tangible medium of the uniform fabric. Even if respondents ultimately succeed in establishing a valid copyright in the surface decorations at issue here, respondents have no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in this case appear. They may prohibit only the reproduction of the surface designs in any tangible medium of expression—a uniform or otherwise.⁶⁴

Thus, the majority apparently was of the opinion that the "shape, cut, and dimensions" of a uniform are "utilitarian aspects" to which copyright does not extend. But why?

The Sixth Circuit's majority opinion is superior in at least one respect: it *does* expressly identify the utilitarian functions or aspects of the cheerleading uniforms: "namely to cover the body, wick away moisture, and withstand the rigors of athletic movements."⁶⁵ The Sixth Circuit also explained why it rejected the district court's view that a blank cheerleading uniform lacked one of the essential functions of a uniform:

Star contends that cheerleading uniforms identify the wearer as a cheerleader and a member of a cheerleading team But this is no different than saying that a utilitarian aspect of a cheerleading uniform is to convey to others the fact that the wearer of the uniform is a cheerleader for a particular team.⁶⁶

The Sixth Circuit also rejected any "decorative" function of an article as a "utilitarian aspect" of the article, on the ground that "[s]uch a holding would render nearly all artwork unprotectable."⁶⁷ This is consistent with the legislative history, which indicates that separable decorative elements, such as "a carving on the back of a chair or a floral relief design on silver flatware" can be protected by copyright.⁶⁸

⁶⁴ *Id.* at 1013. *See also id.* at 1016 ("In any event, as explained above, our test does not render the shape, cut, and physical dimensions of the cheerleading uniforms eligible for copyright protection.").

⁶⁵ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 490 (6th Cir. 2015) (internal quotation marks omitted), *aff'd*, 137 S. Ct. 1002 (2017).

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668.

The Supreme Court offered a different reason for rejecting the district court's view that a blank cheerleading uniform lacked one of the essential functions of a uniform:

The debate over the relative utility of a plain white cheerleading uniform is unnecessary. The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.

Of course, because the removed feature may not be a useful article—as it would then not qualify as a pictorial, graphic, or sculptural work—there necessarily would be some aspects of the original useful article “left behind” if the feature were conceptually removed. But the statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one The statute does not require that we imagine a nonartistic replacement for the removed feature to determine whether that *feature* is capable of an independent existence.⁶⁹

This passage is, frankly, nonsensical. The removed feature either contributes to the utility of the useful article or it doesn't. If it does contribute to the utility of the useful article, then it is one of the “utilitarian aspects” of the article that are not protected by copyright.⁷⁰ If it doesn't contribute to the utility of the useful article, then, by definition, the useful article would remain equally useful without it. The key to applying the “equally useful” argument is to remember that, because of the two statutory exclusions in the definition of a “useful article,” certain types of utility are excluded and simply don't count when deciding whether the article remains “useful.” In other words, the reason a blank cheerleading uniform is less useful than a colorful one is because it fails to convey information; but conveying information is a “utilitarian function” that is excluded from the definition of a “useful article.” A blank cheerleading uniform remains equally useful in all of the ways that matter to the statutory definition.

Fortunately, Justice Thomas' flawed reasoning should not affect the outcome of the separability analysis. He expressly recognizes that the removed feature cannot itself be a “useful article,”⁷¹ and earlier in the opinion he expressly recognizes that the statutory definition of a “useful article”

⁶⁹ *Star Athletica*, 137 S. Ct. at 1013-14.

⁷⁰ “Such works shall include works of artistic craftsmanship insofar as their form *but not their mechanical or utilitarian aspects are concerned*.” 17 U.S.C. § 101 (2012) (emphasis added).

⁷¹ *Star Athletica*, 137 S. Ct. at 1013-14.

includes “[a]n article that is normally a part of a useful article,”⁷² i.e., any functional component of a useful article. Thus, the majority’s insistence that the “imagined remainder” need not be a fully functional useful article at all should be a null set, since any “utilitarian aspects” of the removed feature would necessarily disqualify the removed feature from being a separable pictorial, graphic, or sculptural work.

VI. CONCLUSION

One can certainly argue that the “shape, cut, and dimensions” of a cheerleading uniform⁷³ are utilitarian “aspects” of the uniform that contribute to its ability “to cover the body, wick away moisture, and withstand the rigors of athletic movements.”⁷⁴ Such a conclusion is consistent with the legislative history, which lists “ladies’ dress” as among the “useful articles” that are subject to separability analysis.⁷⁵ But to reach such a conclusion implicitly, without expressly identifying the utilitarian functions that the article serves, fails to provide sufficient guidance to lower courts. Instead, as explained above, the first three questions of the Sixth Circuit’s five-question approach should be adopted by other courts in addressing the antecedent question of “what is a useful article”?

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⁷² *Id.* at 1010 (“Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article or ‘[a]n article that is normally a part of a useful article’ (which is itself considered a useful article)” (citing 17 U.S.C. § 101)).

⁷³ *Id.* at 1013.

⁷⁴ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 490 (6th Cir. 2015), *aff’d*, 137 S. Ct. 1002 (2017).

⁷⁵ H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668 (“Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.”).